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EXAMINER
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ART UNIT	PAPER NUMBER
3305	7

DATE MAILED: 11/03/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☒ Responsive to communication filed on 12-17-91. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I: THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449. 1 sheet 4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474. 6. ☐ _____

Part II: SUMMARY OF ACTION

1. ☒ Claims 1-22 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-22 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

With respect to Figures 6 and 7, elements 74 and 75 bear explanation in the specification, Col. 3 line 31 --Elements 74 and 75 are conductors and insulative portions, respectively, and are used analogously to such elements in the previous figures.--

Claim 21 is lacking and accordingly the claims "33" and "23" have been re-numbered as --21-- and --22-- respectively and reference is made to such in future discussion.

Claim 21 (originally presented as 22) is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependency of this claim is unclear as no original claim 21 was provided.

All claims are examined on the merits herein.

Claims 1-3 and 7-22 are rejected under 35 USC 251 as being based upon an insufficient reissue declaration. The reissue declaration fails to comply with 37 CFR 1.175 (a)(3) and (a)(5) for the following reasons:

(a) The declaration fails to specifically point out how the errors in the specification arose or occurred as required by 37 CFR 1.175(a)(5). The declaration indicates how and when the errors were discovered but item 6 indicates that applicants are unclear as to how the specification errors arose.

(b) The declaration fails to specifically point out how the

errors in claims 1-3 and 7-22 arose or occurred as required by 37 CFR 1.175(a)(5). The declaration comment that there is uncertainly as to the origin of the errors is deemed insufficient and lacking in facts indicating how the errors arose or occurred. See MPEP Section 1414.

(c) The declaration fails to (1) distinctly specify the excess or insufficiency in claims 7-22 and (2) specifically point out how the errors in claims 7-22 arose or occurred as required by 37 CFR 1.175(a)(3) and (a)(5). Regarding item (1), the declaration fails to specify how the reissue overcomes the defect in the original patent, e.g. describe how the newly presented or amended claims 7-22 differ from those of the original patent (claims 1-6). With respect to item (2), the declaration's statement in item 12 for example that deletion of requirement of a support rod would better protect the invention is insufficient to explain the facts as to how and when the errors arose such that method and kit claims are now presented.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-6, 16-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Northeved (German Offen. 2455401).

Northeved shows an apparent amniocentesis sampling needle and stylet in Figure 3. The abstract and page 4 paragraph 2 descriptive of Figure 3 (roughly) appear to suggest a stylet 38 having placed or set therein a miniature piezoelement 40 and leads 42, 44 coupled to an amplifying circuit in conventional manner, and the received signal is highlighted on a B-scan display with a bright or cyclically gleaming light point. element 42 appears to be grounded to the inner surface of the stylet rod or tube. It would have been obvious in view of Figure 1 to provide a dampening material (18) adjacent a transducer (12) and insulate leads such as 14, 16 from each other. Syringe barrel 32 is inherently detachable.

Note that Northeved is a structural analog of a blood sampling system, and that at least some space occurs between the stylet and the needle wall such that slight fluid penetration may occur.

Claims 14-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Omiyo ('079) in view of Northeved as applied to

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claim NEEDS INSERTION above, and further in view of NEEDS
INSERTION.


The former shows a blood-vessel locating technique using a syringe needle-insert. It would have been obvious in view of Northeved to locate a transducer within an syringe insert using the inner wall of the stylet insert tube to either support or electrically couple (?) to a transducer lead.

Claims 7-13 avoid the art of record.

Applicant's offer to surrender the original patent is noted.

Any inquiry concerning this communication should be directed to F. Jaworski at telephone number (703) 308-3061.

F. Jaworski:lf
October 20, 1992


FRANCIS JAWORSKI
PRIMARY EXAMINER
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